

## REMARKS

Applicants have herein canceled claims 11-16 and 19-21, without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter encompassed by all canceled claims in subsequent continuing applications. New claims 22-25 have been added.

Claim 1 has been amended to more clearly describe a scaffolded fusion polypeptide as comprising one or more modules, each module comprising a functional polypeptide domain fused to a scaffolded domain. Support for this amendment can be found, for example, at paragraph 12 of the specification as filed. Claim 2 has been amended to depend from claim 1 and to more clearly describe a scaffolded fusion polypeptide comprising a plurality of modules. Support for this amendment can be found, for example, at paragraph 12 of the specification as filed. Claim 3 has been amended to replace the phrase "wherein the" with the phrase "comprising a" and to insert the word "which." Claim 5 has been amended to list SEQ ID NOs:3 through 7 as being preferred metal chelating motifs in the polypeptides of the instant invention. Support for this amendment can be found, for example, at paragraphs 58, 60 and 61 of the specification as filed. Claim 9 has been amended to replace "SEQ ID NO:6" with "SEQ ID NO:10." Claim 17 has been amended to incorporate the method recited in canceled claim 16. New claims 22-25 have been added to more particularly point out and distinctly claim the subject matter Applicants regard as the invention. Support for new claim 22 can be found, for example, at paragraph 12 and in Figure 1B of the specification as filed. Support for new claim 23 can be found, for example, at paragraphs 60 and 61 of the specification as filed. Support for new claim 24 can be found, for example, at paragraph 72 and at paragraph 81 of the specification as filed. Support for new claim 25 can be found, for example, at paragraph 148 and in Table 4 on page 41 of the specification as filed. No new matter has been added.

Upon entry of the present amendments, claims 1-10, 17-18, and 22-25 will be pending.

### ***Provisional Election With Traverse***

Applicants have herein canceled claims 11-16 and 19-21, without prejudice or disclaimer. The Examiner has required an election under 35 U.S.C. § 121 of one of five groups. The Examiner contends that the individual groupings are distinct, each from each other. *See*, Paper No. 9, pages 2-4.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the invention of Group I (original claims 1, 3-5 and 17) drawn to scaffolded fusion polypeptides.

With respect to the Examiner's division of the invention into five groups and the reasons stated therefor, Applicants respectfully traverse.

Even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". (*See* M.P.E.P. § 803.) In the present situation, the Examiner has failed to make such a showing.

Applicants submit that a search of polynucleotide claims of the invention would provide useful information for examining claims directed to both polynucleotides and the polypeptides encoded by these polynucleotides. This is true because the polynucleotide sequence of these claims is defined by the polypeptide that the polynucleotide sequence encodes. Further, Applicants point out that, in many if not most publications, where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence of the encoded polypeptide.

Further, searches of publications directed to polypeptides and method of screening molecules that bind to those polypeptides would clearly be overlapping. This is so because in publications that describe methods of screening molecules that bind and/or modulate scaffolded fusion polypeptides, the molecules being screened would be defined by their ability to bind and/or modulate the scaffolded fusion polypeptides. Thus, a search of scaffolded fusion polypeptide claims would also provide the Examiner with art directed to the manner in which molecules could be screened to identify those that bind, activate or modulate the scaffolded fusion polypeptide.

In view of the above, Applicants submit that the searches for polynucleotides, polypeptides, and methods of screening molecules that bind, inhibit, activate or modulate polypeptides of the subject invention would clearly be overlapping. Accordingly,

Applicants request that the Examiner reconsider and withdraw the restriction requirement and examine the subject matter of Groups I-V together in the present application.

Alternatively, Applicants respectfully request that the restriction requirement be reconsidered and modified to combine Groups I-III. Applicants point out that the amended claim set submitted herewith more clearly illustrates the relationship between the polypeptides of the instant invention. All of the claims in Groups I-III fall within the genus defined by claim 1, which is now the only independent claim in these groups. Specifically, the scaffolded fusion polypeptide of claim 1 and the scaffolded fusion polypeptide of amended claim 2 differ only in the number of modules present in the polypeptide. The presence of more than one module in a scaffolded fusion polypeptide does not present a serious additional burden for the Examiner. Both forms of scaffolded fusion polypeptides described in claims 2 and 22 are species of the genus of scaffolded fusion polypeptides recited in claim 1. Furthermore, claims 3-9 and 23-25 further define preferred scaffolded fusion proteins of the instant invention and are, thus, additional species claims. Claim 17 is directed to the scaffolded fusion polypeptides of claim 1 produced by a certain process. Thus, Applicants respectfully submit that pending claims 1-9, 17 and 22-25 all belong to the same group and request that they be examined together. This is further required by section 809.04 of the MPEP, which states, "If a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim."

Moreover, should the Restriction Requirement be made final, Applicants respectfully request that upon indication of allowable polypeptide claims, the Examiner rejoin the claims of Group V with the allowed claims. Since the claims of Group V are related the polypeptide claims of the instant invention as between a product and a process for using the product, and since the process claims include all the limitations of the product, the Examiner in any case would be obligated to rejoin the method claims of Group V if the polypeptide claims are found allowable. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. See 1184 OG 86 (March 26, 1996). Specifically, the notice states that "in the case of an elected product

claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim." *Id.* Accordingly, Applicants respectfully request that if the polypeptide claims are found allowable, the process claims of Group V be rejoined and examined for patentability.

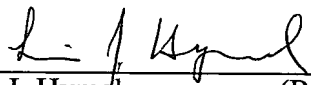
Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

### ***Conclusion***

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Date: 9-12-03

  
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